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09/291,294	04/14/1999	CRIS T. PALTENGHE	CITI0131-US	1910

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EXAMINER

NORMAN, MARC E

ART UNIT PAPER NUMBER

3744

DATE MAILED: 02/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/291,294

Applicant(s)

PALTENGHE ET AL.

Examiner

Marc E. Norman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, 8, 10-12, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81 and 93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5,7,8,10-12,19,20,22-24,28-32,34,38-41,48-50,72,73,75-81 and 93.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments, see paper #20, filed 19 December 2003, with respect to the rejection(s) of claim(s) 1, 3, 5, 7, 8, 10-12, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, and 93 under Fischer, Rosen, Public Legal Education of Nova Scotia, and Shannon have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Carman et al.

For the record, the Examiner accepts Applicant's arguments set forth in paper #20 that, given the four previously applied references, it would not have been obvious to one of ordinary skill in the art at the time of the invention to have come up with Applicant's claimed invention, nor would one have had specific motivation to do so. Further, and more specifically, the Examiner accepts that the refutation set forth by Applicant regarding key deficiencies of the safety deposit box analogy applied with respect to the Legal Education of Nova Scotia reference:

*On the contrary, there is patently no escrow of the contents of the safe deposit box for the renter of the box by the bank subject to fulfillment of a condition. Rather, in order to prevent inheritance tax fraud, tax laws make it a crime for banks to allow access to the contents of the box after the death of the renter until the tax authorities complete their own inventory of the box with the limited exception of searching in the presence of a bank employee for the will or burial plot deed on presentation of a death certificate by the decedent's next-of-kin. Otherwise, there is absolutely nothing to stop the renter or anyone else with a key to the box from accessing its contents at any time during the lifetime of the renter. Likewise, after the tax authorities complete their inventory, there is absolutely nothing to stop anyone with a key to the box from accessing its contents after the renter's death. (paper #20, page 7, line 27 – page 8, line 9)*

Accordingly, the combined steps of automatically escrowing a secondary aspect of the secret access device for the virtual wallet application by the virtual executor function conditioned on the occurrence of an event that renders the owner incapable of acting on the owner's own behalf; receiving verification of the occurrence of the event by the trusted third party from a personal representative of the owner upon the occurrence of the event; and accessing the stored data by the trusted third party on behalf of the owner's personal representative with the escrowed secret access device do not directly correlate as simply a computerized version of common safety deposit box practice. Applicant's invention is therefore more than a mere automation of well-known banking/executor practices.

The new grounds of rejection are set forth below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 7, 8, 10-12, 19, 20, 22-24, 28-32, 34, 38-41, 48-50, 72, 73, 75-81, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carman et al.

As per claims 1, 32, 41, 81, and 93, Carman et al. discloses a method for securely storing data for an owner comprising storing data D related to the owner's estate (see column 9, line 10 regarding will); local aspect on the terminal (processing device 202) of an owner (client); remote aspect (KRC); assigning primary aspect KS to the user (column 2, lines 14-15); escrowing

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secondary aspect KRCpub conditioned on the event of the owner's death (column 2, lines 25-26; column 9, lines 8-10); periodically updating the remote aspect with data from the client (Figure 9); and receiving verification by a trusted third party of the death of the owner and providing access to the data to the trusted third party (column 9, lines 8-10). Carman does not specifically discuss these features within the context of a "virtual wallet." Nevertheless, Carman et al. discloses each of the key functional elements (storing estate data, local aspect, remote aspect, primary aspect, secondary aspect, updating step, receiving verification step, and accessing data step) of the claims. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the functional elements of Carman et al. to a virtual wallet system for the purpose of protecting and escrowing data therein, particularly since as discussed previously (see for example paper #9), the term "virtual wallet" is a broad term and, for the purposes of patentability, does not in itself define the metes and bounds of the invention.

As per claim 3, Carman et al. discloses the data D being entered at a local aspect terminal (processing device 202: see figure 2 and column 7, lines 25-40).

As per claim 5, Carman et al. does not specifically state that the terminal 202 for the user is a personal computer. Official notice is taken that personal computers are common and well-known processing devices that would have been obvious to one of ordinary skill in the art at the time the invention was made to for the purpose of conveniently allowing the user to connect to the system.

As per claims 7 and 8, Carman et al. does not specifically teach the third party being a financial institution/bank. Official notice is taken that this is simply a particular application of the system of Carmen et al., and one that would have been obvious to one of ordinary skill in the

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art at the time the invention was made, particularly since Carman et al. is directed to controlling access to a user secret (such as a will), which is a common activity of a bank.

As per claims 10-12, official notice is taken that private networks, public networks, and the internet are all common and well-known network structures that would have been obvious for the purpose of connecting the network as shown in Figures 1-4 of Carman et al.

As per claim 19, Carman et al. discloses entering data D onto the local aspect (at encryption step 114 of Figure 1).

As per claims 20 and 48, Carman et al. discloses storing user identification information (column 8, lines 14-22).

As per claim 22, Carman et al discloses encrypting data D with local aspect KS via data encryption 114 to the owner at the client terminal computer (within local storage device 122).

As per claims 23, 28, and 34 Carman et al. discloses assigning the primary (owner's) aspect from the remote aspect KRC (steps 608 and 610 whereby access rule index ARI is sent from KRC to the client) over a network (Figure 4).

As per claim 24, see discussion above regarding similar claim 5.

As per claims 29-31, see discussion above regarding similar claims 10-12.

As per claim 38, Carmen et al. discloses storing the third party's aspect being stored on the remote protected environment KRC (step 608).

As per claims 39 and 40, see discussion above regarding similar claims 7 and 8.

As per claim 49, Carmen et al. discloses escrowing decryption infrastructure (emergency decryption application 116).

As per claim 50, Carmen et al. discloses secret key infrastructure (user secret information 1023-1026).

As per claims 72, 73, and 75, Carmen et al. discloses updating technology aspects of the stored data (Figure 9, regarding updating definitions of ARI).

As per claims 76 and 77, see discussion above regarding similar claims 7 and 8.

As per claim 78, Carman et al. discloses the technology aspect being related to encryption technology (access rule index ARI).

As per claim 79, Carman et al. discloses storing data comprising receiving data from another party (see other person at step 806 of Figure 8; see also column 11, lines 37-43).

As per claim 80, Carman et al. discloses the data being sent via a "trusted communications channel" (column 11, line 40). Carman et al. does not specifically state that communication channel being electronic mail. Official notice is taken that electronic mail is a common and well-known electronic communication channel that would have been obvious to one of ordinary skill in the art for the purpose of conveniently sending electronic information.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN



**MARC NORMAN**  
**PRIMARY EXAMINER**